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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/241,744 02/01/99 EINARSON

M PSI-801

EXAMINER

MMC2/0309

ART UNIT	ZER, J	PAPER NUMBER
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LORRAINE S HIRSCH  
17491 HICKS ROAD  
LOS GATOS CA 95032

285A  
DATE MAILED:

03/09/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>09/241,744</b>	Applicant(s) <b>Einarson et al</b>
	Examiner <b>Dr. Jay L. Politzer</b>	Group Art Unit <b>2856</b>

Responsive to communication(s) filed on Jan 19, 2001

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-25 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 1-25 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

ELECTION/RESTRICTION:

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6 and 16-20, drawn to apparatus and method for in-ground fluid evaluation, classified in class 73, subclass 152.23.
  - II. Claims 7-15, drawn to apparatus for sampling in a hole in the ground, classified in class 73, subclass 864.51.
  - III. Claims 21-25, drawn to a packer, classified in class 166, subclass 120.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions III and I or II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because I and II require a packer but almost any packer can be used. The subcombination has separate utility such as an all purpose packer.
3. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the sampling stock of II need not have the limitations of the sampling stock of

- I. The subcombination in I has separate utility such as sampling in small bore wells.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. A telephone call was made to Lorraine Hersch on 12/12/00 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

**NON-RESPONSIVE AMENDMENT:**

7. The reply filed on 1/19/01 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Applicant failed to elect one of inventions I, II, or III as required by 37 CFR 1.1431. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

**REMARKS:**

8. Applicant's arguments filed 1/19/01 have been fully considered but they are not persuasive.

Applicant argues that the inventions have not been shown to be distinct and that they have not attained

recognition in the art as a separate subject for inventive effort. Schultz and Vroblesky et al show that downhole capture elements are distinct, and have attained recognition in the art as a separate subject for inventive effort. Neither of these patents has been classified in 73/152.23, and both are classified in 73/864.51.

Applicant argues that there is no showing of serious burden on the Examiner. Just because an originating classification is given in the restriction requirement, that fact alone does not mean that a search is restricted to that single classification. Note that the two quoted patents above have a far wider field of search than one sub-class. Therein lies the serious burden on the Examiner.

**INQUIRIES:**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Jay L. Politzer whose telephone number is (703) 305-4930.
10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Hezron E. Williams, can be reached at (703) 305-4705.
11. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4900.

jlp 3/2/01

*Jay L. Politzer*